



BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the District of Delaware appears at page 127 of the record and is reported in 38 F. Supp. 495. The opinions of the Circuit Court of Appeals for the Third Circuit appear at pages 315 and 312 of the record and are reported in 53 U. S. P. Q. 490 and 53 U. S. P. Q. 575.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Third Circuit which petitioner seeks to have reviewed was entered May 12, 1942 (R. 311).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for writ of certiorari.

Specification of Errors

The error which petitioner will urge if the writ of certiorari is issued is that the Circuit Court of Appeals for the Third Circuit erred in holding that the patent in suit was improperly reissued.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

ARGUMENT

I.

The decision of the Court of Appeals that, as a matter of law, the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification does not constitute "inadvertence, accident, or mistake" within the meaning of the Reissue Statute is in conflict with the decisions of this Court and of the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits.

The Reissue Statute, by its terms, authorizes the Commissioner of Patents to reissue a patent to correct errors which have arisen "*by inadvertence, accident or mistake, and without any fraudulent or deceptive intention*".

The requirement that the error of the original patent must have arisen by inadvertence, accident, or mistake has been in all the reissue statutes and was apparently adopted from this Court's decision in *Grant and others v. Raymond*, 6 Peters 218, which was handed down prior to the existence of any statute providing for reissuance of a patent and which led to the creation of the Reissue Statute.

In that case the Court used the words "inadvertence or mistake" and indicated that it used them as the antithesis of "fraud or misconduct on the part of the patentee" (p. 240) and that reissue is justified "if the mistake has been innocently committed by the inventor" (p. 242).

It has been determined by this Court that the requirement of the statute is not satisfied where the error sought to be corrected by reissue is an *error of judgment* on the part of the patentee or his solicitor. The expression "error of judgment" is used by the Court in a restricted legal sense to characterize a situation where deliberate election or choice dictates a course of action.

Thus, in *Miller v. Brass Co.*, 104 U. S. 350, this Court said with reference to the question of "inadvertence, accident or mistake" (p. 355):

"Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed; such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct."

The situations in which "error of judgment" as distinguished from mistake has been adjudicated to exist by this Court fall into two classes. The first class includes errors which might have been rectified by appeal as where the claims sought by reissue were first proposed in the original application but rejected, and the rejection was acquiesced in although an appeal might have been taken from the rejection. *Leggett v. Avery*, 101 U. S. 256, 259; *Dobson v. Lees* and cases cited, 137 U. S. 258, 263-66.

The second situation which this Court has classified as "error of judgment" which does not warrant reissue is where the patentee chooses to disclose and claim in his original patent only a part of the invention to which he might otherwise have been entitled. The failure to include his full invention in the original patent constitutes "error of judgment" and not inadvertence, accident, or mistake. *Coon and Another v. Wilson*, 113 U. S. 268, 277-8; *Huber v. Nelson Mfg. Co.*, 148 U. S. 270, 287-290.

“Inadvertence, accident or mistake”, on the other hand, is ordinarily found where the solicitor fails to define properly or adequately in the claims the invention disclosed in the specification. This was the situation in *Topliff v. Topliff*, 145 U. S. 156, the leading case on the subject of reissues.

In that case the patent was for an improvement in connecting carriage-springs and the claim was changed by providing that the connecting-rods should be “secured directly to the hind axle and front bolster” instead of “to the front and rear axles” as provided in the claim of the original patent. The error was apparent on the face of the patent “since affixing the connecting-rod and springs to the front axle would render it impossible to be turned, and in addition to this, the original drawing shows it affixed to the bolster.” Although the invention was clearly described in the specification, the Court found the erroneous wording of the claim to be “a clear mistake” (p. 164), and after a general review of the earlier decisions of the Court on reissues, said (p. 171):

“The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third

persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."

The Court of Appeals in the present case did not accept this interpretation of the Reissue Statute in applying it to the facts of the instant case.

The Court of Appeals found that the wording of claims 1 to 6 of the original patent was erroneous in that the claims defined the function of Bedell's invention or the problem which is solved rather than the means by which he solved the problem. Then, basing its conclusion solely on the functional nature of the claims, the Court held that the erroneous wording of the claims must be considered, as a matter of law, to be the result of deliberate intention constituting an "error of judgment" and not an "inadvertence, accident, or mistake" within the statute.

In the words of the Court (R. 320):

"It is much more rational to conclude, as we do, that they drew the functional claims with the intention of covering any and all means which might be devised in the future to solve the problem which Bedell's particular means solved. *Since the law does not permit the making of a functional claim this action of Bedell's solicitors, if it can be considered an error, was clearly no more than an error of judgment.* But an error of judgment, even though made by the solicitor and not by the patentee himself, is binding upon the patentee and may not be rectified by a reissue patent." (Emphasis added.)

This conclusion of the Court was derived entirely from the face of the original patent. There was no extrinsic

evidence that the patentee or his solicitor harbored any fraudulent intention. While the Court permitted itself to surmise that the patent solicitor deliberately drew claims broader than the law permits,* its decision is plainly predicated on the proposition that the drafting of a claim functional in form constitutes *per se* an *error of judgment* and not "inadvertence, accident, or mistake" within the statute (opinion, R. 321). This conclusion is in direct conflict with the decision of this Court in *O'Reilly v. Morse*, 15 How. 62 in which the principles set forth in *Topliff v. Topliff* were applied to a situation of the same nature as that presented here.

In that case, the eighth claim of Professor Morse's patent for the telegraph was held invalid as being for the function or result of the invention rather than the means by which the function or result were effectuated. And though this invalid claim was in the patent for 13 years and its functional nature was apparent on the face of the patent the court did not hold the patent invalid but permitted the defective claim to be expunged. In that case it was to be cancelled by disclaimer. However, the disclaimer

*This surmise based on the Court's belief that the claims were obviously functional and invalid is opposed to the evidence and findings of the District Court. The District Court on uncontradicted evidence found that neither the plaintiff nor Professor Bedell, the patentee, knew that any claims of the original patent were invalid until shortly before the reissue was filed (R. 136) and the evidence further establishes that the functionality and invalidity of the claims was not in fact obvious to persons familiar with the patent law since the several persons who secured rights under the original patent and the several counsel retained by respondent to appraise the validity of the original patent never perceived any defect in the form of the original claim prior to the reissue (*supra* pp. 4-5).

This surmise also disregards the action of the Patent Office in approving the form of the claims as valid.

statute (R. S. 4917)* like the reissue statute, provides that the defect to be corrected must have arisen "through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention * * *". The plaintiff in that case attempted to avoid a holding that the patent was invalid by insisting that even though the claim was invalid there was no necessity to disclaim since the statute contemplated disclaimer only in case of mistakes of *fact*, whereas the drafting of a functional claim constituted a mistake of *law* and did not come within the statute. The Court rejected this argument and held that a mistake of law renders a patent wholly invalid under the disclaimer statute, and, what is of greater interest here, that a mistake of law is a mistake curable by disclaimer and comes equally, with mistakes of fact, within the meaning of the terms "inadvertence, accident, or mistake". Chief Justice Taney said (pp. 120-1):

"It has been urged, on the part of the complainants, that there is no necessity for a disclaimer in a case of this kind. That it is required in those cases only in which the party commits an error in fact, in claiming something which was known before, and of which he was not the first discoverer; that in this case he was the first to discover that the motive power of electro-magnetism might be used to write at a distance; and that his error, if any, was a mistake in law, in supposing his invention, as described in his specification, authorized this broad claim of exclusive privilege; and that the claim therefore may be regarded as a nullity, and allowed to stand in the patent without a disclaimer, and without affecting the validity of the patent."

"This distinction can hardly be maintained."

"* * * The words of the acts of Congress above quoted show that no patent can lawfully issue upon

*The full text of the disclaimer statute RS4917 will be found in the Appendix, page 32.

such a claim. For he claims what he has not described in the manner required by law. And a patent for such a claim is as strongly forbidden by the act of Congress, as if some other person had invented it before him."

"Why, therefore, should he be required and permitted to disclaim in the one case and not in the other? The evil is the same if he claims more than he has invented, although no other person has invented it before him."

* * * * *

"Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled; and he is allowed to do so when the error was committed by mistake."

The Court accordingly permitted Morse to disclaim the functional eighth claim and thus preserve the valid portions of that patent. No distinction can be drawn between the *Morse* case and the instant case on the ground that the disclaimer statute were there involved since the language of the two statutes is identical in this regard and their purpose is fundamentally the same.

The decision in the *Morse* case makes it clear that the drafting of a functional claim by a solicitor does not *per se* establish a deliberate or unlawful intention to claim that which the patentee had not in fact invented and that such action may constitute a mistake of law rectifiable by reissue and not an error of judgment. The case of *Dobson v. Lees*, 137 U. S. 258, relied on by the Court of Appeals in the instant case does not establish a different rule. In that case the patentee sought to add to his patent by reissue a claim that had been passed upon and rejected in the course of the original application. As this Court pointed out, "an interference was dissolved upon condition of the amendment, and the issue of the original letters was predicated

upon its abandonment" (137 U. S. 265). That case, and the Circuit Court decisions also relied on in the Court below, all present typical examples of errors of judgment as defined by this Court (*supra*, p. 13) and are in striking contrast to the present case.

It is true that the Court below stated that its decision was not to be understood as holding that in no case could a valid reissue patent be granted where the error of the original patent lay in the insertion of a functional claim. But it indicated that the only exception contemplated by it was the case of a mechanical error, as where a patent solicitor or his clerk unintentionally inserted a functional claim "in place of other claims" (R. 320-21). This qualification merely emphasizes the position of the Court of Appeals that any error arising by reason of the action of the patent solicitor in drafting the claims constitutes an "error of judgment" and not "inadvertence, accident or mistake" even though the solicitor's action occurred in consequence of a mistaken understanding of the law, or an innocent misapplication of the law to the facts before him. This interpretation of the statute is in direct conflict with the interpretation applied in the decisions of this Court cited above.

Conflict with Other Courts of Appeals

The interpretation of the statute adopted by this Court has been followed by the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits. Thus, it is broadly stated by the Court of Appeals for the Sixth Circuit in *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234, 238:

"The substantial basis of the application for reissue was that the claims were not commensurate with the invention. If Van Kannel, through his solicitor, without intending to do so, drafted or accepted claims not

commensurate with the invention, such act is an 'inadvertence' within the meaning of Rev. Stat. § 4916 (Comp. St. § 9461), which entitled him to a reissue."

The rule has been applied in cases where the mistake was one of fact. In *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276, the patentee, under a misconception as to the scope of the prior art, reissued his patent to omit certain claims appearing in the original patent. Thereafter, learning that the prior art was not so broad as he supposed, he obtained a second reissue in which the original claims were reasserted. The Court of Appeals for the Second Circuit said (p. 281):

"The first reissue was certainly not obtained by 'inadvertence'. It was the result of the deliberate attempt of a patent solicitor to modify an existing patent; but it was, so far as we can see, none the less a mistake, and not merely a mistake of judgment, as when applicant's solicitor submits to rejections by the Patent Office. The mistake was as to what the prior art contained. * * * When this misconception as to the condition of the prior art was discovered, application was promptly made for a second reissue, and the affidavit on which such application was based truthfully stated—at least, there is nothing shown to negative its truthfulness—that the omission from the first reissue of the original claims was a 'mistake'. That there was 'any fraudulent or deceptive intention' we find no evidence at all".

The same rule has been applied in cases where the mistake was one of law. In *Gross v. Norris*, 26 F. (2d) 898, the Circuit Court of Appeals for the Fourth Circuit affirmed the decision of the District Judge and adopted his opinion with regard to this question as it is set forth at 18 F. (2d) 418, 422:

"But a mistake which will justify a reissue need not necessarily be a mistake of fact. The Supreme Court in *Topliff v. Topliff*, supra, comments upon the difficulty in the preparation of the specification and claims of a patent, and indicates that the failure of an inventor to describe his invention with requisite certainty, or to express a claim so as fully to cover an invention, will furnish ground for the reissue if seasonably applied for".

For other cases to the same effect see: *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 852-3, C. C. A. 4; *Houghton v. Whitin Machine Works*, 153 Fed. 740, 746, C. C. A. 1; *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 Fed. 826, 829-31, C. C. A. 7; *American Automotoneer Co. v. Porter*, 232 Fed. 456, 460, C. C. A. 6; *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 Fed. 698, 699-700, C. C. A. 9.

The foregoing decisions of this Court and of the Courts of Appeals of other Circuits are in direct conflict with the decision of the Court of Appeals for the Third Circuit. Grant of a writ of certiorari is requested to settle this conflict.

II.

The decision of the Court of Appeals that, where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, a patentee can be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of a patent is in conflict with the decisions of this Court.

Whether original claims 1-6 are broader than the patent law permits, is a question of law to be determined on the face of the patent. No question of fact is involved. The Court below specifically held that the specification of the original patent "disclosed clearly and in detail the vari-

ous aspects and embodiments of Bedell's invention and the metes and bounds thereof" (R. 320). So that in granting the patent the Patent Office had before it all the facts to determine whether as a matter of law claims 1-6 were valid. The granting of the patent necessarily involved a finding by the Patent Office that claims 1-6 were proper in form and valid in law.

It has been repeatedly held by this Court that, as in the case of any public official acting within the scope of his official duty, the decision of the Commissioner in granting a patent is presumed to be correct. *Philadelphia and Trenton Ry. Co. v. Stimpson*, 14 Peters 448, 458-9; *Agawam Co. v. Jordan*, 7 Wall. 583, 597; *Mitchell v. Tilghman*, 19 Wall. 287, 390; *Tilghman v. Proctor*, 102 U. S. 707, 735; *Westinghouse etc. Co. v. Formica etc. Co.*, 266 U. S. 342, 348.

While the Commissioner's decision is subject to reexamination by the courts, the granting of the patent raises a presumption of validity on which the patentee is entitled to rely until that presumption has been overthrown by new evidence or by a decision of a court overruling the Commissioner's decision. On several occasions this Court has applied this rule to cases of the present type where the question of validity is one of law on the face of the patent and has held that under such circumstances the patentee is entitled to rely on the presumption of validity attending the grant of the patent and need not disclaim* until the validity of his patent has been passed on by a court.

In *Gage v. Herring*, 107 U. S. 640, suit was brought on a reissued patent granted January 16, 1872 and extended for a term of seven years from April 20, 1872, the date on which the original patent would have expired (p. 640).

*In the instant case the patentee elected to cure the possible defect in his patent by reissue rather than by disclaimer. But the same requirement of diligence is exacted in both cases.

The reissue repeated the claim of the original patent and added a new and enlarged claim (p. 644). The Court held the new claim invalid but stated that plaintiffs, upon filing a disclaimer of the new claim, might recover on the old claim. This decision was rendered in 1882, at least ten years after issuance of the reissue patent containing the new invalid claim. On the question of diligence Justice Gray said (p. 646):

“Considering that the question of the validity of the new claim in the reissue is a question of law upon the face of the patent, and that its validity has been sanctioned by the Commissioner of Patents in granting the reissue, and upheld by the Circuit Court, there has been no unreasonable delay in entering a disclaimer; for the plaintiffs were not bound to disclaim until after a judgment of this court upon the question. *O'Reilly v. Morse*, above cited; *Seymour v. McCormick*, 19 How. 96.”

In *Seymour et al. v. McCormick*, 19 How. 96, the Court as a matter of law gave a claim of McCormick's patent for improvements in reaping machines a construction that rendered it invalid. Since the patent had issued in 1845 and this decision was rendered in 1856, the defendant insisted that the delay of eleven years was excessive and that consequently no disclaimer of the invalid claim could be entered and the entire patent should be held void. The Court rejected this contention, saying (p. 106):

“In respect to the question of unreasonable delay in making the disclaimer, as going to the whole cause of action, the court are of opinion that the granting of the patent for this improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in correcting the claim; and that, under the circumstances, the question is one of law. This was decided in the case of the Telegraph (15 How. 121)”.

See also to the same effect *O'Reilly v. Morse* (the Telegraph case), 15 How. 62, 121; *Yale Lock Mfg. Co. v. Sargent*, 117 U. S. 536, 554; *Burdett v. Estey*, 4 Fed. Cas. pages 712, 718 (Case No. 2145).

The decision of the Court of Appeals holding the re-issue invalid for unreasonable delay in its filing, was predicated on its view that an obligation to correct the original patent arose immediately on its issuance (R. 322-3). This view of plaintiff's obligation is in direct conflict with the decisions of this Court above cited which hold that where the question of validity is a question of law on the face of the patent, the patentee is not bound to correct the original patent until after a decision by a court on the question because he is entitled to rely on the presumption of validity attending the grant of the patent.

The Court of Appeals' error arose from its misapplication of the case of *Miller v. Brass Co.*, 104 U. S. 350 (R. 322). In that case the original patent was reissued 16 years after the grant of the original patent, not to correct an error of law occurring in the patent, but to obtain claims of admittedly broadened scope. The Court found that the inadequacy of the original claims to cover fully the invention was immediately apparent upon an inspection of the patent and that therefore a correction if desired should have been applied for immediately.

This decision is not in conflict with the cases cited above nor has it application to the instant case. It is not the duty of the Patent Office to see that an applicant obtains claims which cover his invention in its broadest aspects as it is its duty to see that such claims as are presented are proper. Whether or not the patentee has claimed his entire invention is a matter of fact peculiarly within his knowledge, and one which is addressed directly to his interest. No presumption that the claims are adequate to protect the invention attends the grant of the patent, and hence it is reasonable to exact from the patentee the greatest diligence in scrutinizing the award to

make sure that he has obtained his full due. The legality of the grant, on the other hand, is the particular interest of the Patent Office, and issuance of the patent raises the presumption that every legal requisite has been complied with. The patentee consequently has the right to rely upon the validity of claims so sanctioned until notified of the error by the judgment of a court having jurisdiction to review the decision of the Patent Office.

In this case plaintiff did not wait until after decision to correct any deficiency of the patent although it might have done so under the decisions of this Court. Plaintiff authorized the filing of the reissue when the possible invalidity of claims 1-6 was first called to its attention by counsel while preparing for the present case.

Thus plaintiff's conduct more than measures up to the standard of diligence established by the Supreme Court.

The decisions above cited of this Court are in direct conflict with the decision of the Court of Appeals in this case. Grant of a writ of certiorari is requested to settle this conflict.

III.

The decision of the Court of Appeals that a claim for a combination of elements, functional in form when construed without reference to the specification, is necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define, is in conflict with decisions of this Court and of the Courts of Appeals for the Second, Fourth, Sixth, Seventh and Ninth Circuits and the Court of Appeals for the District of Columbia.

As we have already pointed out, the decision of the Court of Appeals holding the reissue invalid for unreasonable delay was predicated upon its view that an obligation to correct the original patent arose immediately on its issuance.

This view was based on the Court's conception that by reason of the functional nature of the claims the invalidity of the patent was obvious and should have been clear to anyone with even a rudimentary knowledge of patent law (R. 322-3).

In addition to the fact that the Court's ruling disregards the presumption of validity attending the issuance of a patent, the Court's conception that the defective form of the claims rendered them "*obviously invalid*" is in conflict with the decisions of this Court.

It is the general rule that the claim of a patent "must always be explained by and read in connection with the specification" (*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 432). This rule has been given special application in the case of patent claims defective in that when literally construed they define the function or result of the invention instead of the means.

In the early case of *Seymour v. Osborne*, 11 Wall. 516, a claim to an improvement in reaping machinery was attacked on the ground that the claim, when literally construed, was for an effect and not for any particular machinery. The Court held the claim valid, nevertheless, saying (p. 547):

"Where the claims immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way."

In that case the claim contained the words "substantially as described" which referred back to the specification much as does the expression "In a device of the type described—" contained in the claims of the present case.

In *Mitchell v. Tilghman*, 19 Wall. 287, a decision handed down three years later, this Court held that the presence of such words was not even necessary but that they would

be implied in cases where otherwise the claims might be construed as functional. In that case the patent was for a process. In sustaining the claim the Court said (pp. 391-2, 395):

“Usually the claim contains the words as described or substantially as described, or words of like import, which are everywhere understood as referring back to the descriptive parts of the specification. Words of such import, if not expressed in the claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle, or result, which is obviously forbidden by the patent law, as it would close the door to all subsequent improvements.”

* * *

“Limited, as explained by reference back to the descriptive parts of the specification, the claim may well be regarded as in due form, but it is quite clear that it would be invalid if it is not so limited, as it has always been held that a patent embraces nothing more than the improvement described and claimed as new, and that anyone who afterwards discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it and to vend it to others to be used.”

“Apply that rule and it is clear that the invention must be limited to the described method of producing free fat-acids and solution of glycerine from the fatty and oily substances therein mentioned, * * *”

* * *

“Construed and defined as explained, the first issue respecting the patent must be found for the complainant, * * *”.

See to the same effect *The Corn-Planter Patent*, 23 Wall. 181, 225-6.

The same rule has been asserted by the Circuit Courts of Appeals. In a recent decision, *Engineering and Re-*

search Corporation et al. v. Horni Signal Corporation, 98 F. (2d) 682, the Court of Appeals for the Second Circuit stated the rule as follows (p. 684):

“The claims are so general and functional that ver-
bally there can be no reasonable doubt that the defend-
ant infringed them; indeed it scarcely disputes that it
does; it says that they are invalid. The fact that they
are functional need not be conclusive against them;
most claims are so, more or less. *Davis Sewing Ma-
chine Co. v. New Departure Mfg. Co.*, 6 Cir., 217 Fed.
775, 782, 783; *Buono v. Yankee Maid Dress Corp.*,
2 Cir., 77 F. (2d) 274, 277. But when a patentee draws
his claims in that form, he must be content that they
shall be limited at least by such details of the dis-
closure as are necessary to save the patent.”

See also *American Can Company v. Hickmott etc. Com-
pany* (C. C. A. 9), 142 Fed. 141, 146-7; *Arnold v. Tyden*
(C. C. A. 7), 193 Fed. 410, 412; *Outlook Envelope Co. v.*
General etc. Co. (C. C. A. 2), 239 Fed. 877, 878-9; *Bisight*
Co. v. Onepiece Bifocal Lens Co. (C. C. A. 4), 259 Fed.
275, 276; *United Shoe Mach. Corp. v. H. Gordon Co.* (C. C.
A. 6), 59 F. (2d) 903, 904-5; *Demco v. Doughnut Mach.*
Corp. (C. C. A. 4), 62 F. (2d) 23, 25; *Ford Motor Co. v.*
Gordon etc. Co. (C. C. A. 6), 87 F. (2d) 390, 391-2.

In addition to the foregoing circuit court decisions, the
Court of Appeals for the District of Columbia has re-
cently reasserted this rule with reference to a claim strik-
ingly similar to the claims involved here, *Raytheon Mfg.*
Co. of Newton, Mass. v. Coe, 96 F. (2d) 527, 529. Under
this decision the Patent Office is currently granting pat-
ents which are absolutely void under the decision of the
Court of Appeals in the present case.

The Court below relied on *Holland Furniture Co. v. Per-
kins Glue Co.*, 277 U. S. 245 and *General Electric Co. v.*
Wabash Co., 304 U. S. 364 in support of its position. Those
cases do not support the Court's position but on the con-

trary are in accord with the general rule above stated. In both cases this Court sought to supplement the defect of the claims by reference to the descriptive portions of the patent. In the *Holland* case this Court pointed out that the defendant's product did not infringe when the claims were interpreted in the light of the specification. The decree sustaining the bill was reversed, not because the claims of the patent were absolutely void, but because they were invalid if construed literally, and not infringed if construed in the light of the description (277 U. S. 245, 255 and 258). In the *Wabash* case this Court likewise recognized the general rule and sought to sustain the claims by construction. The vice of the patent that led to this Court's holding of invalidity was that the specification, not merely the claim, described the product in functional terms (304 U. S. 364, 373). No such circumstances exist here and the Court of Appeals found as fact (R. 320):

"The specification of the original patent clearly discloses Bedell's concept and the means he employed to solve his problem."

At most, under these decisions the functional form of claims 1-6 brought their validity within the field of debate or of speculation, and this was the ground asserted in the reissue oath (R. 122).

Reissue was proper under such circumstances. Contrary to the lower Court's belief (R. 313-14), absolute invalidity is not a condition precedent of reissue. Reissue is available to remove a doubt as to the validity of a claim and reissued patents have been frequently sustained even when it was subsequently found that the claims would have been valid had their original form been retained (*Hobbs v. Beach*, 180 U. S. 383, 394; *Abercrombie & Fitch Co. v. Baldwin*, 245 U. S. 198, 207; *Traitel Marble Co. v. U. T. Hungerford, etc. Co.* (C. C. A. 2), 18 F. (2d) 66, 69; *Kraft Cheese Co. v. Pabst Corp.*, 17 F. (2d) 787, 791). The same

rule applies to disclaimers (*Carnegie v. Cambria*, 185 U. S. 403, 435-6; *Triplett v. Lowell*, 297 U. S. 638, 640; *United Chromium Co. v. International Silver Co.* (C. C. A. 2), 60 F. (2d) 913, 914-5).

Conclusion

In view of the conflict of decisions above set forth it is urged that the petition for writ of certiorari be granted.

Respectfully submitted,

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.

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